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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,150	12/07/2001	Hans Ott	031211-067	8111
21832	7590	12/16/2005	EXAMINER	
MCCARTER & ENGLISH LLP			PUNNOOSE, ROY M	
CITYPLACE I			ART UNIT	
185 ASYLUM STREET			2877	
HARTFORD, CT 06103			PAPER NUMBER	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/005,150

Applicant(s)

OTT, HANS

Examiner

Roy M. Punnoose

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/20/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-24 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 9, 11-17, 24-29 and 32-39 of copending Application No. 10/004,787. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

- a. Limitations of claim 1 of the instant application are disclosed in claim 1 of copending Application No. 10/004,787.

- b. Limitations of claim 2 of the instant application are disclosed in claim 32 of copending Application No. 10/004,787.
- c. Limitations of claim 33 of the instant application are disclosed in claim 33 of copending Application No. 10/004,787.
- d. Limitations of claim 4 of the instant application are disclosed in claim 34 of copending Application No. 10/004,787.
- e. Limitations of claim 5 of the instant application are disclosed in claim 35 of copending Application No. 10/004,787.
- f. Limitations of claim 6 of the instant application are disclosed in claim 31 of copending Application No. 10/004,787.
- g. Limitations of claim 7 of the instant application are disclosed in claim 24 of copending Application No. 10/004,787.
- h. Limitations of claim 8 of the instant application are disclosed in claim 25 of copending Application No. 10/004,787.
- i. Limitations of claim 9 of the instant application are disclosed in claim 26 of copending Application No. 10/004,787.
- j. Limitations of claim 10 of the instant application are disclosed in claim 27 of copending Application No. 10/004,787.
- k. Limitations of claim 11 of the instant application are disclosed in claim 28 of copending Application No. 10/004,787.
- l. Limitations of claim 12 of the instant application are disclosed in claim 329 of copending Application No. 10/004,787.

- m. Limitations of claim 13 of the instant application are disclosed in claim 36 of copending Application No. 10/004,787.
- n. Limitations of claim 14 of the instant application are disclosed in claim 37 of copending Application No. 10/004,787.
- o. Limitations of claim 15 of the instant application are disclosed in claim 38 of copending Application No. 10/004,787.
- p. Limitations of claim 16 of the instant application are disclosed in claim 39 of copending Application No. 10/004,787.
- q. Limitations of claim 17 of the instant application are disclosed in claim 9 of copending Application No. 10/004,787.
- r. Limitations of claim 18 of the instant application are disclosed in claim 11 of copending Application No. 10/004,787.
- s. Limitations of claim 19 of the instant application are disclosed in claim 12 of copending Application No. 10/004,787.
- t. Limitations of claim 20 of the instant application are disclosed in claim 13 of copending Application No. 10/004,787.
- u. Limitations of claim 21 of the instant application are disclosed in claim 14 of copending Application No. 10/004,787.
- v. Limitations of claim 22 of the instant application are disclosed in claim 15 of copending Application No. 10/004,787.
- w. Limitations of claim 23 of the instant application are disclosed in claim 16 of copending Application No. 10/004,787.

- x. Limitations of claim 24 of the instant application are disclosed in claim 17 of copending Application No. 10/004,787.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seymour et al (US\_5,724,259) in view of Delueg (US\_5,128,710).
5. Claim 1 is rejected because:
- A. Seymour et al (Seymour hereinafter) discloses a device for the pixel-by-pixel photoelectric measurement of a planar or flat object to be measured, comprising a two-dimensional array of light converter elements (see CCD referred to in col.5, lines 25+) for producing electric signals in response to light remitted by the object to be measured; imaging means 70, 72, 74 for imaging the object to be measured onto the two-dimensional array of light converter elements; signal processing means (see abstract) for processing the electrical signals produced by the light converter elements and for converting them into corresponding digital raw measured data; and data processing means (see abstract; col.7, lines 53-65) for processing of the raw measured data into image data representing the colors of the individual pixels of the measured object, the data processing means being constructed for carrying out a scattered light correction for

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reducing scattered light influences. However, Seymour does not disclose filters provided in the imaging light path for wavelength selective filtering of the measurement light impinging on the light converter elements.

B. Delueg discloses filters 13, 13' on a rotating filter wheel 11 provided in the imaging light path for wavelength selective filtering of the measurement light impinging on the light converter elements (see abstract and Figure 1).

C. In view of Delueg's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate filters into Seymour's device due to the fact that it would provide a more accurate results on spectral representation of a sample under test.

*Allowable Subject Matter*

6. With regard to claims 2-24, the prior art of record, taken alone or in combination, fails to disclose or render obvious the limitations of said claims. However, claims 2-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims or if the rejection to the base claim can be overcome with amendment or other means.

*Conclusion*

7. The prior art cited in the accompanying PTO-892 is made of record and not relied upon, is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**.

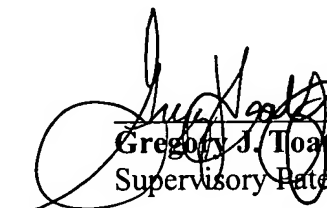
The examiner can normally be reached on 9:00 AM - 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Roy M. Punnoose**  
Patent Examiner  
Art Unit 2877  
December 09, 2005

  
\_\_\_\_\_  
**Gregory J. Toatley, Jr.**  
Supervisory Patent Examiner  
12 Dec 05